

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed February 25, 2005. At the time of the Office Action, Claims 1-3, 6-15, and 18-22 were pending in the Application. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 103 Rejection

The Examiner rejects Claims 1-3, 11-15, and 18 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,353,742 issued to Bach (hereinafter “*Bach*”) in view of U.S. Patent No. 6,590,879 issued to Huang et al. (hereinafter “*Huang*”). The Examiner rejects Claims 7-19 and 19-22 under 35 U.S.C. §103(a) as being unpatentable over *Bach* in view of *Huang* and further in view of U.S. Patent No. 6,141,347 issued to Shaughnessy et al. (hereinafter “*Shaughnessy*”). Applicant respectfully traverses these rejections for the following reasons.

Applicant respectfully reminds the Examiner that in order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>1</sup> It is respectfully submitted that Independent Claim 1 is patentable over the art of record based on, at least, the first and second criterion of obviousness.

Even assuming for the sake of argument that *Huang* and *Shaughnessy* are analogous art, the rejection of the Claims would still be improper because the Examiner has not shown the required suggestion or motivation in *Bach*, *Huang*, and *Shaughnessy*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>2</sup> Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior

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<sup>1</sup> See M.P.E.P. § 2142-43.

<sup>2</sup> M.P.E.P. § 2143.01 (emphasis in original).

art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>3</sup> Nothing in *Bach*, *Huang*, or *Shaughnessy* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>4</sup> Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under the M.P.E.P.<sup>5</sup> and governing Federal Circuit case law.<sup>6</sup> The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.<sup>7</sup>

Thus, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.<sup>8</sup> The factual inquiry whether to combine references must be thorough and searching.<sup>9</sup> This factual question cannot be resolved on subjective belief and unknown authority;<sup>10</sup> it must be based on objective evidence of record.<sup>11</sup>

Furthermore, the Examiner is precluded from modifying the combined teachings of *Bach*, *Huang*, and *Shaughnessy* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The

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<sup>3</sup> *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>4</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

<sup>5</sup> See M.P.E.P. § 2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

<sup>6</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

<sup>7</sup> See M.P.E.P. §2145.

<sup>8</sup> See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

<sup>9</sup> See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

<sup>10</sup> See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

<sup>11</sup> *Id.* at 1343, 61 USPQ 2d at 1434.

cited references must disclose the desirability of making the proposed modification.<sup>12</sup> The fact that the modification is possible or even advantageous is not enough.<sup>13</sup> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.<sup>14</sup>

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. It does not appear that the proffered combinations of *Bach*, *Huang*, and *Shaughnessy* would necessarily be capable of performing the operations required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Huang* could readily be imparted to the configuration of *Bach* to provide an architecture that accommodates a communication session based on signal strength or predicted position associated with the selected mobile station. The proposed combination (presumptively) attempts to combine somewhat divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight, has not addressed the chance that the proposed *Bach-Huang* combination would have any degree of success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

All of the pending claims have been shown to be allowable, as they are patentable over the proposed references. Formal notice to this effect is respectfully requested in the form of a full allowance of all the pending claims.

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<sup>12</sup> *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

<sup>13</sup> See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

<sup>14</sup> *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

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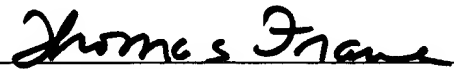
CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
Thomas Frame  
Reg. No. 47,232

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Customer No. **05073**